

In the Claims

Amend claims 8 and 74, to read as follows:¹

A1 8. (Amended) The abrasive free polishing formulation according to claim 6, wherein the dicarboxylic acid is iminodiacetic acid.

A2 74. (Amended) The polishing method according to claim 72, wherein the pH of the formulation is about 3.5.

REMARKS

Response to Restriction Requirement

In the February 6, 2003 Office Action, the Examiner has required restriction under 35 U.S.C. §121, between Group I claims 1-38 directed to a CMP slurry composition and Group II claims 39-75 directed to a method for CMP polishing a metal layer.

In response to the restriction requirement, applicants hereby elect Group I claims 1-38, with traverse.

The traversal is based on the fact that the rationale for restriction in this instance is in error. The Office Action states that "the process for using the product as claimed can be practiced with another materially different product" (see page 2 of the Office Action).

In fact, the CMP formulation recited in claim 1 is the same as that recited in method claim 39, insofar as the specifically recited ingredients of the CMP formulation is concerned. The Office

¹ Consistent with the requirements of 37 C.F.R. §1.121, a marked-up copy of the amended claims 8 and 74 is set forth in Appendix A herein. Consistent with the holding of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, et al., 535 U.S. 722, 152 L.Ed.2d 944 (2002), decided May 28, 2002, any amendments herein that hereafter are deemed to be narrowing amendments by a court of competent jurisdiction in a final unappealed or unappealable decision, are

Action's contention that the method as claimed is not limited to abrasive free slurries ignores the fact that claim 39 is open to the presence or absence of abrasive, and thus is not independent and distinct from claim 1, as is necessary under 35 U.S.C. §121 as a basis for proper restriction.

Further, the statement in the Office Action that the product can be used to CMP polish materials other than those containing a metal layer ignores the fact that the formulation is specifically recited in claim 1 as being "for removing at least a portion of a metal film," consistent with the method specified in claim 39 of "removing at least a portion of a metal film." The Office Action provides no statement of any specific materials that could be polished other than those containing metal layer, and the statement of alternative use ignores the nexus of the composition and method².

It therefore is requested that the restriction requirement be reconsidered, and that all claims 1-75 be retained in consolidated form for further examination and prosecution on the merits.

If the restriction requirement nonetheless is made final, applicants alternatively request rejoinder of method claims 39-75 under the provisions of MPEP §821.04 upon confirmation of allowable subject matter of the Group I claims 1-38.

Election of Species

The Office Action at pages 3-5 further imposes an election of species requirement. Relative to the Group I claims 1-38, the Office Action requires election of any one of Groups 1-5 and any one of Groups 6-7 set out at the lower portion of page 4 of the Office Action. In response, applicants hereby elect species Group 2 ("CMP polish primarily Cu based compounds") and species Group 6 ("use inorganic acid based activator compounds").

Further, relative to the previous arguments for continued consolidation of the composition and method claims for further examination and prosecution, applicants correspondingly elect the same species Groups 2 and 6 ("CMP polish primarily Cu based compounds" and "use inorganic acid based activator compounds," respectively) for the method claims.

not intended to relinquish any scope of equivalents unforeseeable at the time of this amendment or that relate to aspects of the invention having only a peripheral relation to the basis of the amendment.

The following is a listing of claims readable on the elected species, in both the composition and method claims.

Composition Claims Readable on Elected Species

Claims 1-10, 18-20 and 22-38 are readable on the elected species.

Method Claims Readable on Elected Species

Claims 38-48, 56-58 and 60-75 are readable on the elected species.

Amendment of Claim 8 to Overcome Objection Thereto

At page 2 of the Office Action, claim 8 has been objected to as being a composition claim, and not a method claim. In response, claim 8 has been amended herein to recite same as a composition claim, with claim 8 depending from composition claim 6.

In like manner, claim 74, which has been objected to as a method claim and not a composition claim as recited, has been amended herein to recite same as a method claim.

Accordingly, claims 8 and 74 are now in fully proper form.

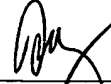
CONCLUSION

It therefore is requested that reconsideration of the restriction requirement be made on the basis of the foregoing remarks, and that examination and prosecution of all claims 1-75 correspondingly result. In the event the restriction requirement is finalized, rejoinder is requested under the provisions of MPEP §821.04.

With the election and species and amendment of claims herein, the application is in form and condition for further examination.

² Under the generalized approach of the Office Action, any unrelated use could be theoretically hypothesized - e.g., that the claim composition could be put into a container and used as a door stop composition, but such alternative use would not constitute an appropriate basis for restriction under the requirements of 35 U.S.C. §121.

Respectfully submitted,



Steven J. Hultquist
Reg. No. 28,021
Attorney for Applicants

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
P.O. Box 14329
Research Triangle Park, NC 27709
Phone: (919) 419-9350
Fax: (919) 419-9354
Attorney File No.: 2771-520 (7486)

APPENDIX A

(Marked-Up Version of Amended Claim 8)

8. (Amended) The abrasive free polishing formulation [method] according to claim 6, wherein the dicarboxylic acid is iminodiacetic acid.

74. (Amended) The polishing method [abrasive free polishing formulation] according to claim 72, wherein the pH of the formulation is about 3.5.